



JFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **John A. McFarland, et al.**

Application No.: **10/817,563**

Examiner: **Tuan N. Quach**

Filed: **April 2, 2004**

Group Art Unit: **2826**

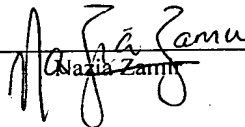
For: **HIGHLY SELECTIVE SILICON OXIDE ETCHING COMPOSITIONS**

Attorney Docket No.: **H0004908 (P25,370-A USA)**

CERTIFICATE OF MAILING

I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service on April 27, 2006 with sufficient postage as first class mail addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: April 27, 2006


Nazia Zaman

Mail Stop Amendment
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Reply to Requirement for Restriction Dated March 28, 2006

Sir:

In response to the Examiner's Action mailed March 28, 2006, applicants hereby traverse the Examiner's Requirement for Restriction set forth therein and respectfully request reconsideration and withdrawal of the Requirement.

The Examiner has required restriction between the following groups of claims:

Group I – Claims 1-7, which are directed to a solution, classified in class 510, subclass 108;

Group II – Claims 8-23, which are directed to a method of removing oxides from metal surfaces, classified in class 438, subclass 758.

The basis for the Examiner's Requirement for Restriction is that he considers the claim groups to be distinct in that the solutions of claim Group I can be used in methods other than that of claim Group II.

It is respectfully submitted that the Examiner's Requirement is deficient on its face because 35 U.S.C. § 121 requires that the involved inventions be not only distinct, but also independent. Clearly, the inventions defined in the claims of Groups I and II are not independent in that the Group II claims define a process solely for use with the product of the Group I claims.

The Examiner has recognized apparently that the claim groups do not define independent inventions because he has not characterized them as being independent. Moreover, the Examiner has not even attempted in his Action to explain why he considers the claims to be directed to independent inventions. Consequently, the Examiner has issued a requirement that is deficient on its face because he has not explained why the two claim groups are considered to define independent subject matter. Accordingly, the Requirement should be withdrawn.

It is submitted further that the Examiner's Requirement should be withdrawn because it is believed that a proper search of the subject matter of the Group I claims or the Group II claims requires that a search be conducted for the subject matter of both groups of claims. This is because the subject matter of the claims is so interrelated. For example, the Group I claims are directed to a solution and the Group II claims are directed to a method of using the solution of the Group I claims.

Applicant(s): John A. McFarland, et al.
Application No. 10/817,563
Page 3

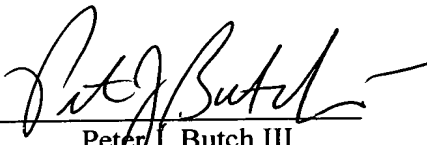
Docket No. P25,370-A USA

As requested by the Examiner, applicants elect provisionally with traverse to prosecute Group I solution claims 1-7. Applicants respectfully request that, upon indication of allowable subject matter with regard to the elected claims, the withdrawn method claims, which include all the recitations of the product claims, be rejoined for examination of patentability (M.P.E.P. Section 821.04).

It is believed that the claims in this application are in condition for allowance. A favorable action on the merits is respectfully requested. If there are any additional charges in connection with this amendment, the Examiner is authorized to charge Applicant's Deposit Account No. 19-5425 therefor.

Respectfully submitted,

Dated: April 27, 2006


Peter J. Butch III
Reg. No. 32,203

Synnestvedt, Lechner & Woodbridge LLP
P.O. Box 592
112 Nassau Street
Princeton, NJ 08542-0592
Telephone: 609-924-3773
Facsimile: 609-924-1811